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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/765,511	01/19/2001	Daniel R. Kiselik	A-99.59.1	9510

7590

03/13/2006

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EXAMINER

PASS, NATALIE

ART UNIT

PAPER NUMBER

3626

DATE MAILED: 03/13/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	<b>Application No.</b>		<b>Applicant(s)</b>	
	09/765,511		KISELIK, DANIEL R.	
	<b>Examiner</b>		<b>Art Unit</b>	
	Natalie A. Pass		3626	

**-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --**

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 5 December 2005 and 15 December 2005.
- 2a) ☒ This action is **FINAL**.                      2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-34 is/are pending in the application.
- 4a) Of the above claim(s) 15-34 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-14 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
     Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
     Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |   |   |
|---|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)                        | 4) <input type="checkbox"/> Interview Summary (PTO-413)                     |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)    | Paper No(s)/Mail Date. _____  |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| Paper No(s)/Mail Date _____   | 6) <input type="checkbox"/> Other: _____                                    |

***Notice to Applicant***

1. This communication is in response to the amendments filed 5 December 2005 and 15 December 2005. Claims 1-14 have been elected with traverse. Claims 15-34 are withdrawn from further consideration by the Examiner, 37 CFR 1.142(b), as being drawn to a non-elected invention. Grounds of rejection for claims 1-14 are presented in the instant application as set forth in detail below.

2. This application contains claims 15-34 drawn to an invention nonelected with traverse in the Response to Restriction Requirement filed 15 March 2005. A complete reply to the final rejection must include cancellation of nonelected claims or other appropriate action (37 CFR 1.144) See MPEP § 821.01.

***Claim Rejections - 35 USC § 103***

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

4. Claims 1, 8 are rejected under 35 U.S.C. 103(a) as being unpatentable over Fraser, U.S. Patent Number 5, 664, 115 in view of Gindlesperger, U.S. Patent Number 6, 397, 197 for substantially the same reasons given in the previous Office Action (paper number 05272005). Further reasons appear hereinbelow.

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(A) Claims 1 and 8 have been amended to now recite, "[...] mutually determined [...]" in their preambles and in lines 29 and 30, respectively.

As per the inclusion of this feature, Fraser teaches "a method and apparatus of automatically matching sellers of property with potential buyers through a communications network in which a host system communicates with the sellers and the potential buyers over telephone or dedicated data transmission lines" (Fraser; column 3, lines 8-13) that comprises "permitting a prospective "buyer" (reads on "requestor") to select a group of properties [of a "seller" (reads on "satisfier") based on a set of criteria" (Fraser; column 3, lines 1-2) and also comprises "automatic evaluation of potential "buyers" (reads on "requestors") to screen buyers whose information does not match minimum criteria provided by the "seller" (reads on "satisfier")" (Fraser; Abstract). Examiner interprets these teachings as reading on these newly added limitations.

The remainder of claims 1 and 8 is rejected for the same reasons given in the prior Office Action (paper number 05272005, section 6, pages 3-8), and incorporated herein.

The motivations for combining the respective teachings of Fraser and Gindlesperger are as given in the rejection of claim 1 in the prior Office Action (paper number 05272005) and incorporated herein.

5. Claims 2-3, 9-14 are rejected under 35 U.S.C. 103(a) as being unpatentable over Fraser, U.S. Patent Number 5, 664, 115 in view of Gindlesperger, U.S. Patent Number 6, 397, 197 as applied to claim 1 above, and further in view of The Feedback Forum web pages, 1999. URL: <http://web.archive.org/web/19990428182410/pages.ebay.com/aw/feedback.html> for substantially

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the same reasons given in the previous Office Action (paper number 05272005). Further reasons appear hereinbelow.

(A) Claims 11-14 have been amended to now recite, "[...] mutually determined [...]" in their preambles and in lines 18-19, 13, 18-19, and 13, respectively.

As per the inclusion of this feature, Fraser teaches "a method and apparatus of automatically matching sellers of property with potential buyers through a communications network in which a host system communicates with the sellers and the potential buyers over telephone or dedicated data transmission lines" (Fraser; column 3, lines 8-13) that comprises "permitting a prospective "buyer" (reads on "requestor") to select a group of properties [of a "seller" (reads on "satisfier") based on a set of criteria" (Fraser; column 3, lines 1-2) and also comprises "automatic evaluation of potential "buyers" (reads on "requestors") to screen buyers whose information does not match minimum criteria provided by the "seller" (reads on "satisfier")" (Fraser; Abstract). Examiner interprets these teachings as reading on these newly added limitations.

The remainder of claims 11-14 is rejected for the same reasons given in the prior Office Action (paper number 05272005, section 7, pages 8-12), and incorporated herein.

The motivations for combining the respective teachings of Fraser and Gindlesperger and The Feedback Forum are as given in the rejection of claims 1 and 2 in the prior Office Action (paper number 05272005) and incorporated herein.

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(B) Claims 2-3, 9-10 have not been amended and are rejected for the same reasons given in the previous Office Action (paper number 05272005, section 7, pages 8-12), and incorporated herein.

6. Claims 4-7 are rejected under 35 U.S.C. 103(a) as being unpatentable over Fraser, U.S. Patent Number 5, 664, 115 in view of Gindlesperger, U.S. Patent Number 6, 397, 197 as applied to claim 1 above, and further in view of Breitfeld, P. et al., Pilot Study of a Point-of-use Decision Support Tool for Cancer Clinical Trials Eligibility. J Am Med Inform Assoc. 1999 Nov-Dec; 6(6): 466-477, URL: <http://www.pubmedcentral.nih.gov/picrender.fcgi?artid=61390&blobtype=pdf>, hereinafter known as Breitfeld for substantially the same reasons given in the previous Office Action (paper number 05272005). Further reasons appear hereinbelow.

(A) Claims 4-7 have not been amended and are rejected for the same reasons given in the previous Office Action (paper number 05272005, section 8, pages 12-14), and incorporated herein.

### ***Response to Arguments***

7. Applicant's arguments filed 5 December 2005 and 15 December 2005 have been fully considered but they are not persuasive. Applicant's arguments will be addressed hereinbelow in the order in which they appear in the response filed 5 December 2005.

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(A) At pages 16-21 of the 5 December 2005 response, Applicant argues that the newly added features in the 5 December 2005 amendment are not taught or suggested by the applied references. In response, all of the limitations which Applicant disputes are missing in the applied references, including the features newly added in the 5 December 2005 amendment, have been fully addressed by the Examiner as either being fully disclosed or obvious in view of the teachings of Fraser, Gindlesperger, The Feedback Forum, and Breitfeld, based on the logic and sound scientific reasoning of one ordinarily skilled in the art at the time of the invention, as detailed in the 35 USC § 103 rejections given in the preceding sections of the present Office Action and in the prior Office Action (paper number 05272005), and incorporated herein. In particular, Examiner notes that automatically determining a mutually satisfactory arrangement between parties and automatically establishing a mutually determined sub-group of satisfiers, are taught by the cited references. In particular, Examiner interprets Fraser's teachings of "a method and apparatus of automatically matching sellers of property with potential buyers through a communications network in which a host system communicates with the sellers and the potential buyers over telephone or dedicated data transmission lines" (emphasis added) (Fraser; column 3, lines 8-13) that includes "permitting a prospective "buyer" (reads on "requestor") to select a group of properties [of a "seller" (reads on "satisfier")] based on a set of criteria" (emphasis added) (Fraser; column 3, lines 1-2) and also comprises "automatic evaluation of potential "buyers" (reads on "requestors") to screen buyers whose information does not match minimum criteria provided by the "seller" (reads on "satisfier")" (emphasis added) (Fraser; Abstract).as teaching these limitations.

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At the paragraph bridging pages 17-18 of the 5 December 2005 response, Applicant argues that in the applied references “[t]here is no information in the system pertaining to a seller which is utilized to assure that a mutually satisfactory arrangement is arrived at automatically within the system itself” and that “the seller is not even system-qualified” and that “ ... there is no comparison of information pertaining to both the buyer and the seller in order to establish a sub-group of sellers ...” Examiner respectfully disagrees. Specifically, Examiner interprets Fraser’s teachings of

“[t]he data management, storage, and retrieval application ... [...] ... organizes the information exchanged with prospective buyers and that provided from sellers. . This information is organized and stored within the environment of the operating system 32 on one or more mass storage devices, such as the one referred to in FIG. 2. An example of the manner by which the data corresponding to this information is organized and stored is described below in reference to FIGS. 4A to 4C” (emphasis added) (Fraser; column 5, lines 17-25)

as teaching maintaining information in the system pertaining to both buyers and sellers;

and Examiner interprets Fraser’s teachings of

“[a]lso included in the software environment is a buyer evaluation application 38 which screens potential buyers on behalf of the seller” (Fraser; column 5, lines 26-28)

as teaching automatically establishing a sub-group of buyers or “requestors” that satisfy a seller (or as “narrowing” or “paring down” the group);

and Examiner interprets Fraser’s teachings of

“[o]nce a prospective buyer enters the system, he or she accesses information ... [...] ... the buyer can ... [...] ... input a sorting criteria to select only preferred ones of the



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property listings (S107). For example, if searching for particular businesses being offered for sale, the prospective buyer specifies particular locations, ranges of sales volumes or SIC codes ... [...] ... [o]nce prospective buyer's criteria is received, the host system executes a search of all listings in accordance with the input criteria” (emphasis added) (Fraser; column 6, lines 40-51)

as teaching automatically establishing a sub-group of sellers or “satisfiers” that satisfy a buyer (or as “narrowing” or “paring down” the group);

and Examiner interprets Fraser’s teachings of

“the buyer inputs the buyer's selection criteria. This criteria may include, the property type (that is, real estate, business, personal property) location, expense, and so forth. Once the criteria has been entered, at S403 the system executes a search of all property records, and then displays the search results” (emphasis added) (Fraser; column 9, lines 9-14) and

“[a]fter a provisional buyer record has been created, the aforementioned evaluation process is executed at S409 to determine whether the buyer meets the seller's minimum qualification standards for each selected property. The results of this evaluation are then displayed to the prospective buyer at S410, who is then asked at S411 if it is desired to forward the buyer's information to the seller of the matching items. If not, the prospective buyer is asked whether a new search is desired at S406. On the other hand, if the prospective buyer wishes to contact the seller, the buyer's provisional record is stored on disk at S412 and the appropriate matching seller and property listing records are updated at S413 to reference the buyer's record. The host system then provides a confirmation to the buyer that the buyer's information will be forwarded to the appropriate seller (S414), and the buyer is given the option to perform a new search (Fraser; column 9, lines 27-43)

as well as Gindlesperger’s teachings of

“compares and correlates the vendor selection criteria data to the vendor capability data field of each vendor data record in the buyer's vendor pool database ... [...] ... transmits a vendor's invitation-for-bid data to each vendor in the buyer's vendor pool whose vendor capability data field meets the vendor selection criteria data extracted from the buyer's invitation-for-bid data ... [...] ... server receives a plurality of responding bid data, each being from a corresponding one of the plurality of vendors to whom a vendor invitation-for-bid data was transmitted, and each representing the transmitting vendor's price for the particular print information goods or services requested ... [...] ... then selects the responding bid data having the lowest represented vendor price and generates information identifying the buyer of the identity of the selected vendor,” (emphasis added) (Gindlesperger; column 5, lines 10-27)

as teaching “comparison of information pertaining to both the buyer and the seller in order to establish a sub-group of sellers” and automatically establishing a “mutually satisfactory arrangement;”

and Examiner interprets Fraser's teachings of

“[p]rior to posting the listing on the host system for access to prospective buyers, the seller's account is checked at S104 to ensure that the seller is in good standing with the host system” (Fraser; column 6, lines 12-15) and “[e]ach record further includes a field indicative of whether the seller is approved for access to the system” (Fraser; column 7, lines 34-36)

as teaching “a system-qualified satisfier.”

At pages 18-20 Applicant argues that the applied references fail to take into account “any requirements of the buyer pertaining to the seller” and “paring down the number of potential

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vendors to a sub-group ... to quickly identify a smaller group of parties ...” Examiner respectfully disagrees, for reasons as discussed above.

In response to Applicant's argument at pages 19-21 of the 5 December 2005 response that there is no suggestion to combine the references, the Examiner recognizes that obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either in the references themselves or in the knowledge generally available to one of ordinary skill in the art. See *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988) and *In re Jones*, 958 F.2d 347, 21 USPQ2d 1941 (Fed. Cir. 1992). In addition, the test for obviousness is not whether the features of a secondary reference may be bodily incorporated into the structure of the primary reference; nor is it that the claimed invention must be expressly suggested in any one or all of the references. Rather, the test is what the combined teachings of the references would have suggested to those of ordinary skill in the art. See *In re Keller*, 642 F.2d 413, 208 USPQ 871 (CCPA 1981).

Furthermore, the Examiner recognizes that references cannot be arbitrarily altered or modified and that there must be some reason why one skilled in the art would be motivated to make the proposed modifications. And although the motivation or suggestion to make modifications must be articulated, it is respectfully submitted that there is no requirement that the motivation to make modifications must be expressly articulated within the references themselves. References are evaluated by what they suggest to one versed in the art, rather than by their specific disclosures, *In re Bozek*, 163 USPQ 545 (CCPA 1969).

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The Examiner is concerned that the Applicant apparently ignores the mandate of the numerous court decisions supporting the position given above. The issue of obviousness is not determined by what the references expressly state but by what they would reasonably suggest to one of ordinary skill in the art, as supported by decisions in *In re Delisle* 406 Fed 1326, 160 USPQ 806; *In re Kell, Terry and Davies* 208 USPQ 871; and *In re Fine*, 837 F.2d 1071, 1074, 5 USPQ 2d 1596, 1598 (Fed. Cir. 1988) (citing *In re Lalu*, 747 F.2d 703, 705, 223 USPQ 1257, 1258 (Fed. Cir. 1988)). Further, it was determined in *In re Lamberti et al* 192 USPQ 278 (CCPA) that:

- (i) obvious does not require absolute predictability;
- (ii) non-preferred embodiments of prior art must also be considered; and
- (iii) the question is not express teaching of references but what they would suggest.

According to *In re Jacoby*, 135 USPQ 317 (CCPA 1962), the skilled artisan is presumed to know something more about the art than only what is disclosed in the applied references. In *In re Bode*, 193 USPQ 12 (CCPA 1977), every reference relies to some extent on knowledge of persons skilled in the art to complement that which is disclosed therein. In *In re Conrad* 169 USPQ 170 (CCPA), obviousness is not based on express suggestion, but what references taken collectively would suggest.

In the instant case, the Examiner respectfully notes that each and every motivation to combine the applied references is accompanied by select portions of the respective reference(s) which specifically support that particular motivation. As such, it is NOT seen that the Examiner's combination of references is unsupported by the applied prior art of record. Rather, it is

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respectfully submitted that explanation based on the logic and scientific reasoning of one ordinarily skilled in the art at the time of the invention that support a holding of obviousness has been adequately provided by the motivations and reasons indicated by the Examiner, *Ex parte Levengood* 28 USPQ 2d 1300 (Bd. Pat. App. & Inter., 4/22/93).

As such, it is respectfully submitted that Applicant appears to view the applied references separately and in a vacuum, without considering the knowledge of average skill in the art, and further fails to appreciate the breadth of the claim language that is presently recited.

### ***Conclusion***

8. **THIS ACTION IS MADE FINAL.** See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

9. **Any response to this final action should be mailed to:**

Box AF

Commissioner of Patents and Trademarks  
Washington D.C. 20231

**or faxed to:** (571) 273-8300.

For formal communications, please mark  
"EXPEDITED PROCEDURE".

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For informal or draft communications, please label  
"PROPOSED" or "DRAFT" on the front page of the  
communication and do NOT sign the communication.

After Final communications should be labeled "Box AF."

10. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Natalie A. Pass whose telephone number is (571) 272-6774. The examiner can normally be reached on Monday through Thursday from 9:00 AM to 6:30 PM. The examiner can also be reached on alternate Fridays.

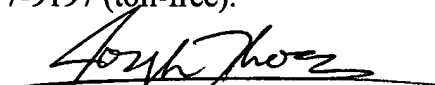
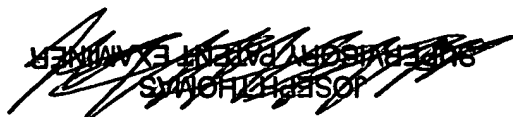
11. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Joseph Thomas, can be reached at (571) 272-6776. Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Receptionist whose telephone number is (571) 272-3600. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

12. Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



Natalie A. Pass

February 21, 2006

  
JOSEPH THOMAS  
SUPERVISORY PATENT EXAMINER  
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